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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,750	10/23/2003	Joachim B. Kohn	P22,591-D USA	7747

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/691,750	Applicant(s) KOHN ET AL.	
	Examiner D. L. Jones	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 4/25/05 wherein the specification was amended and claims 1, 16, 18, and 24 were amended. In addition, the Examiner acknowledges the acceptable terminal disclaimer filed over US Patent No. 6,602,497.

Note: Claims 1-34 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENTS

2. The Applicant's arguments/amendment filed 4/25/05 to the rejection of claims 1-34 made by the Examiner under 35 USC 112 and/or double patenting have been fully considered and deemed persuasive-in-part for the reasons set forth below.

Double Patenting Rejections

I. The double patenting rejection over copending application number 10/691,749 is WITHDRAWN because the copending application has been canceled.

II. The double patenting rejection over copending application number 10/796,847 is WITHDRAWN because the copending application has been canceled.

III. The double patenting rejection over US Patent No. 6,602,497 is WITHDRAWN because Applicant has filed an acceptable terminal disclaimer.

IV. The provisional rejection over application number 10/288,076 has been converted to a non-provisional double patenting rejection (as set forth below) because the application has issued as a patent. Thus, the provisional double patenting rejection is WITHDRAWN in view of the non-provisional rejection below.

112 Second Paragraph Rejections

The 112 rejections are WITHDRAWN for reasons of record in Applicant's response filed 4/25/05.

NEW GROUNDS OF REJECTIONS

Double Patenting Rejection

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

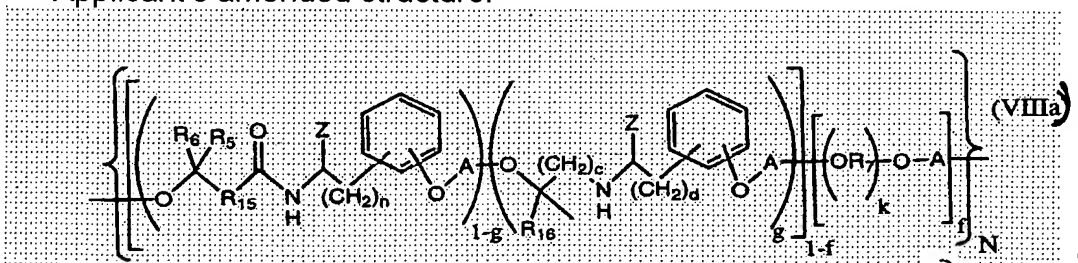
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-16, 19, 21, 22, 24-27, and 31-33 of U.S. Patent No. 6,852,308. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to radioopaque devices comprising a radioopaque iodine- or bromine substituted polymer. The claims of the instant invention differ from those of the patented claims in that the claims of the instant invention are narrower in scope than the patented claims. Thus, a skilled practitioner in the art would recognize that the patented claims encompass those of the instant invention.

New Matter in Specification

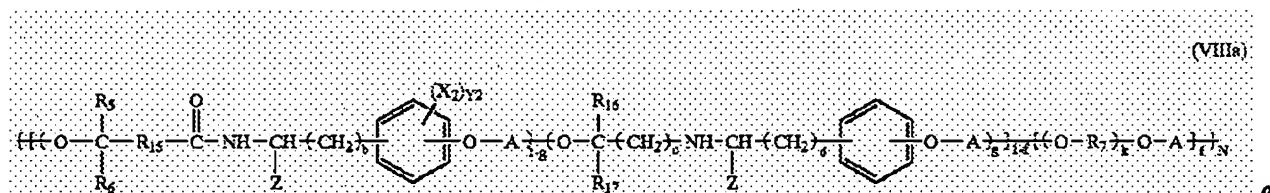
5. The amendment filed 4/25/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the amendment which replaces the structures at page 10, lines 11 and 12 is not consistent with that in the originally filed disclosure. In particular, the amended structure (see below) does not include the (X₂)Y₂ group attached to the aryl structure of formula (VIIIa). In addition, the (CH₂)_n group should be (CH₂)_b and the R₁₇ group is absent from the amended structure (please see structure (VIIIa) appearing in PGPubs US 2004/0086461, page 4, paragraph [0036]).

Applicant's amended structure:



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The structure appearing in PGPubs US 2004/0086461 (page 4, paragraph [0036]).



Applicant is required to cancel the new matter in the reply to this Office Action.

COMMENTS/NOTES

6. It should be noted that no prior art has been cited against the instant invention; however, Applicant **MUST** address and overcome the double patenting rejections. In particular, the claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious a radioopaque medical implant having the formula as set forth in independent claims 1 and 18. The closest prior art is Applicant's own work over which double patenting rejections were made.

7. The amendment to Structure (IIlc) as set forth in the response filed 4/25/05 is not new matter because the amended structure is consistent with the parent structure (III) which discloses the attachment of the variable Z to the CH group.

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Applicant is respectfully requested to delete 'VIII' from claim 1, line 4 or place '(VIII)' under the structure for clarity of the claim because one could possibly get the variables of the structure and formula confused since they are so close to one another.


8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

July 7, 2005